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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,826	03/10/2004	Dieu Dai Huynh	AVERP3525USB	1916
81029 7590 04/24/2009 Avery Dennison Corporation Amanda Wittine 8080 Norton Parkway 22-1D Mentor, OH 44060				
EXAMINER				
GILLESPIE, BENJAMIN				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
04/24/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,826

Applicant(s)

HUYNH, DIEU DAI

Examiner

BENJAMIN J. GILLESPIE

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10, 12 and 13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 7-10, 12 and 13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 7-8, 10, 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Reischl et al ('995).
2. The rejection has been previously set forth on paragraph 2 of the office action mailed 9/23/2008, and is herein incorporated by reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7-10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schafheutle et al (U.S. Patent 5,334,690) in view of Bagaglio et al (EP 0,358,328) and Ozawa et al (US PG Pub 2002/0176968).
4. The rejection has been previously set forth on paragraphs 3-6 of the office action mailed 9/23/2008, and is herein incorporated by reference.
5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reischl et al ('972) in view of Rhoades et al ('824).

6. The rejection has been previously set forth on paragraphs 7 and 8 of the office action mailed 9/23/2008, and is herein incorporated by reference.

Response to Arguments

7. Applicant's arguments, filed 1/20/2009, with respect to the rejection of:

- a) Claims 7-8, 10, 12-13 as being anticipated by Reischl et al ('095).
- b) Claims 7-10, 12 and 13 as being unpatentable over Schafheutle et al (U.S. Patent 5,334,690) in view of Bagaglio et al (EP 0,358,328) and Ozawa et al (US PG Pub 2002/0176968), and
- c) Claim 9 as being unpatentable over Reischl et al ('972) in view of Rhoades et al ('824).

8. Have been fully considered but they are not persuasive.

9. **Regarding issue a):** Applicants argue the claimed invention is not anticipated by Reischl et al, there is not teaching to blend *two initially isolated* aqueous dispersions: the first comprising claimed (a) component and the second comprising the claimed (b) component.

10. In response, although Reischl et al is silent in teaching a method of blending *two initially isolated and solvent free* aqueous dispersions, claim 7 is not limited to such methodology.

Instead, it merely requires a *blend* of solvent free polyether-polyurethane resin dispersion + polyester-polyurethane resin dispersion. Contrary to applicants' assertions, the language: "a blend of: (a) first... aqueous dispersion" and "(b) second... aqueous dispersion" fails to require each resin being *initially isolated* from one another – the scope of claim 7 is drawn to a *blend* of multiple dispersions (emphasis added).

11. Furthermore, if applicants maintain the language of claim 7 is sufficient to establish product-by-process limitations requiring a blend of *two isolated* dispersions – it should be noted that absent showing of criticality, process limitations in a product-by-process claim do **not** carry patentable weight. Therefore, the examiner maintains the blend of (a) and (b) satisfy claim 7.

12. Applicants also argue the coating disclosed by Reischl et al would inherently fail to act as a dye transfer layer based on sedimenting and redispersible properties – however, this position has not been supported by any type of factual data and appears to be an unsubstantiated opinion which is not persuasive.

13. **Regarding issue b):** Applicants argue the claimed invention is patentable over the prior art because one of ordinary skill would not be motivated to modify the polyether-polyester-polyurethane resin of Schafheutle et al into a blend of polyether polyurethane + polyester polyurethane based on the fact that:

- i) Bagaglio et al is drawn to the production of elastomers, i.e. fails to teach water dispersible polyurethane resin,
- ii) Ozawa et al fails to teach a blend of two distinct polyurethane resin dispersions, and
- iii) Paragraph 24 of Ozawa et al does not teach “an amount of polyether polyol relative to an amount of polyester polyol in the polyurethane backbone.

14. Regarding i) and iii) and contrary to applicants' assertions, Ozawa et al do in fact teach that the content of polyether relative to polyester controls the resulting feel of the polyurethane coating (emphasis added – see paragraphs 23 and 24 of Ozawa et al).

15. Moreover, it is noted that Bagaglio et al fail to teach water-dispersible polyurethane resins, however it is still a relevant secondary teaching since it establishes how separate polyether polyurethane and polyester polyurethane increase the homogeneity of the resulting polyurethane. Furthermore, one of ordinary skill would be motivated to rely on Bagaglio et al in view of Ozawa et al, since Ozawa et al teach polyester and polyether each impart different properties in the final polyurethane, i.e. by synthesizing separate polyether and polyester polyurethane resins, the polyether and polyester blocks will be uniformly distributed throughout the final polyurethane backbone – this ensures uniform distribution of material properties.

16. Concerning issue ii) it is noted that Ozawa et al fail to teach two distinct polyurethane dispersions, however, as previously discussed in paragraphs 9-12 of the instant rejection, this position is not commensurate in scope with claim 7.

17. **Regarding issue c):** Applicants argue claim 9 is patentable over the prior art because the relied upon layer of Rhoades et al is dye permeable – not dye receptive. While applicants' remarks have been noted, motivation to glean the relied upon cross-linking agent still exists since Rhoades et al teach it is suitable for cross-linking aqueous dispersions of polyurethane resin (the same methodology of Reischl et al), and said cross-linking agent produces coatings having excellent resistance to solvent, which are relevant in the final applications of Reischl et al, i.e. paint and lacquer (Reischl et al: col 7 lines 39-41).

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN J. GILLESPIE whose telephone number is (571)272-2472. The examiner can normally be reached on 8am-5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 1796

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